AMENDMENTS TO THE DRAWINGS

Fig.1 has been amended to include an additional numeric reference. An amended Fig. 1 drawing is attached showing the change in red ink. Please substitute this replacement drawing for the drawing currently on file.

REMARKS

In response to the above-identified Office Action, Applicants' have amended Fig. 1 to illustrate the check valve at the exit passage and have cancelled claim 18. Applicants have supplied herewith a corrected drawing sheet for Fig. 1, labeled "Replacement Sheet".

The abstract of the disclosure has been amended to overcome the objection.

The Examiner has objected to claims 2-15, 17-20, and 23-30 for using an introductory initial direct article as opposed to a referential introductory direct article. The claims have been amended.

Further the Examiner has objected to claims 17 and 28 for being improperly written markush-type groupings. Applicants have reviewed the MPEP § 2173.05(h) and all other sections of the MPEP that are related to markush-type groupings. Applicants do not believe that there is any inherent indefiniteness to the claims as written. Each of the claims requires that at least one of A, B, C or D be present and only then allows for other elements to be combined with one of A, B, C or D. Because A, B, C or D are definite and are required there should be no difficulty in determining the meets and bounds of the claim and therefore Applicants do not believe the claim should be considered indefinite. If the Examiner is not actually arguing that the claim is indefinite but merely that it lacks the traditionally recognized terminology, Applicants note that 2173.05(h) paragraph 6 in the MPEP indicates that "... 'if wherein R is a material selected from the group consisting of A, B, C or D' is a proper limitation, then 'wherein R is A, B, C or D' shall also be considered proper". It is believed that this authorization of language supports the terminology utilized in Applicants' claims. In view hereof, Applicants respectfully request that the objections to the claims be withdrawn.

Claims 26 and 27 have been rejected under 35 U.S.C. § 112, second paragraph for being indefinite. The Examiner states that the claims are "indefinite because it is unclear

how the wellbore is either elastically or plastically expanded ." The Examiner further indicates that she believes what is intended by the Applicants is that the element is elastically or plastically expanded. In fact Applicants did intend to indicate that the wellbore is elastically or plastically expanded. Applicants submit that the wellbore itself can be elastically expanded by putting sufficient radially, expanding pressure on the wellbore itself through this element to move it in an expanding way to a degree that will allow rebound when the pressure is relieved. It is also possible, however, to put sufficient pressure in the element as described herein to cause the wellbore to plastically deform such that it will not rebound to its originally dimension upon release of pressure inside the element. Applicants do not believe that the concept should considered indefinite and therefore respectfully request withdrawal of the rejection.

The Examiner has rejected claims 1-3, 5-14, 16, 19-27, 29 and 31 in view of 35 U.S.C. S 102(e) for being anticipated by Watson. Applicants would like to point out that in claims 1 and 16 an expandable element is required to be radially, outwardly positioned of the base pipe and the screen. In the Watson et al. reference this is not the case, the Examiner refers to the base pipe as 16 but the expandable element 56 is not disposed radially outwardly of the base pip 16. It is only positioned longitudinally adjacent the base pipe 16. Applicants' claims 1 and 16 both require that the expandable element be disposed radially outwardly of both the base pipe and the screen. This is not shown in Watson et al. In an effort to expedite the prosecution of the present application Applicants have elected to make this even more clear by amendment to independent claims 1 and 16 as set forth hereinabove. Applicants note that the Examiner has rejected claim 31 in this rejection however has not addressed it. It is believed that the Examiner included claim 31 in the listing inadvertently as there does not appear to be any disclosure within Watson et al. related to claim 31.

Claims 4, 15 and 30 have been rejected under 35 U.S.C. § 103(a) for being unpatentable over Watson et al. There is no teaching, disclosure nor even a suggestion in Watson to lead one of ordinary skill in the art to make this modification. There is no basis to

arrive at the conclusion drawn by the examiner notwithstanding the fact that in hindsight the examiner is able to justify the conclusion by using applicant's teaching regarding dehydration through the expandable member to the advantage of the teaching in Watson. It is not surprising to Applicant that the Examiner believes that using a portion of the applicants' invention might benefit the Watson configuration, but that does not make it obvious to do so. The motivation to make a modification of a primary reference must be found in the prior art, and may not use the desirable nature of applicants' achievement as a basis for motivation among the prior art. The Examiner has not supplied a reference or the teaching to suggest to the ordinarily skilled artisan that this would be done. Moreover, without some suggestion in Watson, it would appear from the teaching of Watson that a permeable member would be contrary to the teaching thereof, to wit: paragraph 0040 describes the element as one that is elastomeric and retains pressurized fluid.

Regarding claim 15, a check valve in the exit passage of Watson et al. would have closed off the ID of the device, not a particularly advantageous solution where production through the device is likely to be desired. It would seem to Applicants that it would counterintuitive to provide a check valve in the device of Watson et al. and therefore Applicants do not believe that it is obvious to include such a check valve.

Regarding claim 30, the fact that it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice does not suggest to one of ordinary skill in the art that a particulate component of a particulate fluid combination should be less dense than that of the fluid with which it forms a slurry. What suitability would be served here? What would lead someone to make this choice? With respect to matter of obvious design choice one would have thought that the particulate would be *more* dense than the fluid so that it would fall into place properly as it was pumped. It is not likely that one of ordinary skill in the art would have come to the conclusion that a less dense particulate matter would be desirable for this purpose under any circumstances. It is therefore counterintuitive and if that is the case, then

it certainly is not a matter of obvious design choice. One of ordinary skill in the art certainly would not have chosen to make the particulate matter less dense than the fluid during design of their configuration; the lack of a reference to support the rejection is ample evidence of this.

Claim 17, 18, and 28 have been rejected under 35 USC § 103(a) for being unpatentable over Watson et al. in view of Brookes et al. The Examiner has stated that Brookes et al. teaches cement and that is a sufficient teaching to render obvious Applicants' teaching that the particulate matter is coated with a material that bonds the individual particles together over time. Applicants note that cement is a slurry type of material wherein the individual particles are not initially coated with any specific material but rather are put into a hardenable fluid. The fluid then hardens and fixes the particles in place. This is very distinct from a material that coats the individual particles prior to placement and then binds them together. Moreover, Applicants note that the Examiner has taken the position that to modify the packer of Watson et al. such that it is inflated with the cement would have been disastrous. Watson et al. clearly teaches that a screen 54 would allow the dehydration of the slurry into the ID of the device. In order for cement to harden effectively the amount of hydration thereof is required to be correct. That means that dehydration of the cementious slurry through the screen would be undesirable from a chemical standpoint. Moreover from a mechanical standpoint the cement material that migrates through the screen into the ID of the device will harden therein rendering the device useless with respect to production. One of ordinary skill in the art would certainly never utilize cement in the device of Watson et al. Applicants respectfully request withdrawal of the rejection.

In the event the Examiner has any queries regarding the instantly submitted amendment, Applicants' attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are any additional charges with respect to this Response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by the Applicants' Attorneys.

Respectfully submitted,
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